

REMARKS

In view of the following remarks, the Examiner is respectfully requested to allow Claims 22-29 and 32-39 the only claims pending and currently under examination in this application after entry of the above amendments.

Claims 38 and 39 have been added. Support for Claims 38 and 39 may be found throughout the specification and claims as originally filed. For instance, support may be found at paragraphs 30 and 13, respectively. Accordingly no new matter has been entered.

As no new matter has been entered by way of these amendments, their entry is respectfully requested.

Claim Rejections - 35 U.S.C. § 102

Claims 22-27 have been rejected under 35 U.S.C. § 102 (b) as allegedly being anticipated by Kurdi et al. (U.S. Patent No. 5,932,113).

According to the M.P.E.P § 2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim.

Claim 22, and the claims dependent thereon, is directed to a method for forming a slider assembly. The method includes arranging a plurality of sliders, each having a surface such that the surfaces are coplanar to each other, dispensing a silicon-based encapsulant fluid in a manner effective to fill gaps or recesses between the sliders, without contacting the coplanar slider surfaces; and subjecting the dispensed encapsulant fluid to conditions effective for the fluid to form a readily debondable solid encapsulant comprising a silicon-based polymer. Accordingly, an element of Claim 22 includes a silicon-based encapsulant fluid that forms a readily debondable silicon-based solid encapsulant.

Kurdi does not anticipate Claim 22 because Kurdi does not teach the use of a silicon-based encapsulant fluid that forms a readily debondable silicon-based solid encapsulant. Rather, Kurdi teaches the use of a curable acrylate fluid, which although it may contain silicone, forms into a solid encapsulating material that is resistant to solvents and developers. As set forth in the Applicants' specification at paragraph 7,

“...the curable encapsulants described in Kurdi et al... often exhibit unfavorable bonding and/or debonding performance. In particular, cured epoxy materials, e.g., pure thermosetting epoxy resins, can be removed from sliders only with great difficulty and often leave significant material residue on the slider surfaces.”

Accordingly, the acrylate fluid used in Kurdi does not form a readily debondable solid encapsulant, but rather, forms an encapsulating material that is only removed “with great difficulty and often leave significant material residue on the slider surfaces.”

Therefore, in view of the above, Kurdi does not teach all the elements of Claim 22 because Kurdi fails to teach the use of a silicon-based encapsulant fluid that forms a readily debondable silicon-based solid encapsulant. Consequently, because Kurdi fails to teach all the elements of the rejected claims it fails to anticipate the claimed invention and the Applicants respectfully request this rejection be withdrawn.

Claim Rejections - 35 U.S.C. § 103

Claims 22-29, 32-34, 36 and 37 have been rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Kurdi in view of Mandell (U.S. Patent No. 3,335,088) and Wong (U.S. Patent No. 5,051,275).

According to the MPEP § 706.02 (j), to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable

expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

As set forth above, an element of Claim 22 includes the use of a silicon-based encapsulant fluid that forms a readily debondable silicon-based solid encapsulant. As described above, Kurdi is deficient in that it fails to teach the use of a silicon-based encapsulant fluid that forms a readily debondable silicon-based solid encapsulant. Rather, Kurdi teaches an acrylate encapsulating material that is not readily debondable but is only removed "with great difficulty and often leaves significant material residue on the slider surfaces." As Mandell was cited solely for the proposition that acrylic and silicone elastomer based encapsulants are functionally equivalent, and Wong was cited for its disclosure of a silicone based polymer having phenyl substituents, neither Mandell nor Wong remedy the deficiencies of Kurdi.

In view of the above, a *prima facie* case of obviousness has not been established because the recited combination fails to teach all the elements of the rejected claims, namely, a silicon-based encapsulant fluid that forms a readily debondable silicon-based solid encapsulant. Therefore, the Applicants respectfully request that this rejection be withdrawn.

Claim 35 has been rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Kurdi in view of Mandell and Wong and further in view of Joffre et al. (U.S. Patent No. 5,840,800) and Wong (U.S. Patent No. 4,564,562).

Claim 35 ultimately depends from Claim 22. As set forth above, an element of Claim 22 includes a silicon-based encapsulant fluid that forms a readily debondable silicon-based solid encapsulant. As described above, the combination of Kurdi, Mandell and Wong is deficient in that it fails to teach a silicon-based encapsulant fluid that forms a readily debondable silicon-based solid encapsulant. As Joffre was cited solely for the proposition that amino based catalysts are functionally equivalent to metallic catalysts, and Wong was cited for its disclosure of a dialkylaminoalkylsiloxane catalyst, neither Joffre nor Wong remedy the deficiencies of the combination of Kurdi, Mandell and Wong.

In view of the above, a *prima facie* case of obviousness has not been established because the recited combination fails to teach all the elements of the rejected claims, namely, a silicon-based encapsulant fluid that forms a readily debondable silicon-based solid encapsulant. Therefore, the Applicants respectfully request that this rejection be withdrawn.

New Claims

New Claims 38 and 39 depend from Claim 22. Accordingly for at least the reasons set forth herein above with respect to Claim 22, new Claims 38 and 39 are patentable.

CONCLUSION

In view of the amendments and remarks above, the Applicants respectfully submit that all of the claims are in condition for allowance, which action is requested.

Respectfully submitted,

By: 

James Nolan
Registration No. 53,393
c/o MINTZ LEVIN
1400 Page Mill Road
Palo Alto, California 94304-1124
(650) 251-7700 Telephone
(650) 251-7739 Facsimile
Customer Number 23980